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10/022,773	12/20/2001	Noriaki Ogishima	217573US2	6918

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/022,773

Applicant(s)

OGISHIMA, NORIAKI

Examiner

Calvin L Hewitt II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1, 2, 4-7 and 9-39 have been examined.

***Response to Amendments/Arguments***

2. Applicant has amended the claims to include the term "configured".

However, what an apparatus or system is configured to do represents "intended use", and as the prior art recites Applicant's structural limitations, Applicant's claimed apparatus and system are not distinguished from the teachings of the prior art (*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)).

Claims 2, 7, 12, and 19 recite a method, system and apparatus for requesting the enciphered data with respect to a server or apparatus. In light of the Specification (paragraphs 58, 66, 70, 76, 78 and 95), however, claims 7, 12, 19, are interpreted as request generating step or part to request data from an external apparatus wherein the data is *to be* enciphered by the transmitted enciphering key.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 4-7, 9 and 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "decipher *enciphered* data" in lines 8 and 9 (emphasis added). Claim 6 recites a similar limitation. There is insufficient antecedent basis for this limitation in claims 1 and 6.

Claims 4-7, 9 and 10 are also rejected as each depends from claim 1 or 6.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 11-14 and 18-21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stefik et al., U.S. Patent No. 6,233,684.

As per claims 11-14 and 18-21, Stefik et al. teach an image forming apparatus comprising:

- requesting data from a server (column 14, lines 40-51)
- enciphering requested data and transmitting said enciphered data over a network (column/line 14/65-15/5)
- receiving and deciphering enciphered data with a printing function (column 15, lines 5-25)
- determining whether deciphered data is valid and printing valid deciphered data (i.e. user has view or play "right" and not "print" right) (figures 6, 7 and 15; column 9, lines 3-10, 28-40, and 55-60; column 18, lines 55-59)
- request generating at terminal equipment to request data from an external apparatus or server, wherein the data is to be enciphered by the transmitted enciphering key (column/line 14/65-15/3)

***Claim Rejections - 35 USC § 103***

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 6, 7, 15, 22, 25-27, 29-31, 35, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 in view of Perlman, U.S. Patent No. 6,363,480.

As per claims 1, 2, 6, 7, 9, 15, 22, 25-27, 29-31, 35, 38, and 39, Stefik et al. teach an image forming apparatus comprising:

- a key sending part to an external apparatus (column 14, lines 57-61)
- deciphering part for deciphering enciphered data received from an external apparatus (column/line 14/63-15/13)
- a judging part to determine whether deciphered data is valid (i.e. user has view or play "right" and not "print" right) printing part to print valid data (figures 6, 7 and 15; column 9, lines 3-10, 28-40, and 55-60; column 18, lines 55-59)

- receiving enciphered data from an external apparatus (column/line 14/65-15/3)
- request generating at terminal equipment to request data from an external apparatus or server, wherein the data is to be enciphered by the transmitted enciphering key (column/line 14/65-15/3)
- accounting processing with respect to enciphered data (column 15, lines 54-65)

Stefik et al. teach viewing and selecting a digital work over the internet using a browser. The Examiner takes Official Notice that thumbnails and summaries in hypertext are well-known computer programs for allowing an internet user to select internet content. Stefik et al. also teach online accounting where an external apparatus is notified of the actions performed on the user end (column 15, lines 56-65), hence it would have been obvious to one of ordinary skill to configure the system of Stefik et al. to track how user interacts with content (column 9, lines 28-62). Stefik et al. do not specifically generating keys. Stefik et al. disclose a method for securing content using a combined symmetric and asymmetric system. Specifically, Stefik et al. teach enciphering content with a symmetric or secret key (e.g. DES), enciphering the secret key with a user public key and transmitting the enciphered key and content to the user. However, Stefik et al. are silent regarding the source of the secret key (column/line 14/57-15/5). Perlman teaches a suitable system for generating secret keys. The Perlman

system operates as follows: a sending party who desires to securely transmit data to a receiving party requests a secret key from said receiving party, the receiving party generates the key and transmits the key to the sending party, who in turn enciphers the data with the key and transmits the enciphered data to the receiving party (abstract; column 3, lines 10-17; column 6, lines 4-11). Since the key is symmetric, the receiving party retains the key (copy or original) in order to decipher the enciphered data. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al. and Perlman in order to ensure limited access to content ('480, column 6, lines 13-17; '684, column 5, lines 55-59).

8. Claims 4, 5, 9, 10, 16, 17, 23, 24, 28, and 32 re rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Perlman, U.S. Patent No. 6,363,480 as applied to claims 1, 6, 15, and 22, and in further view of Chou et al., U.S. Patent No. 5,337,357.

As per claims 4, 5, 9, 10, 16, 17, 23, 24, 28, and 32, Stefik et al. teach a secure content distribution system where content is enciphered and access is determined by creator rights (figures 6, 7, and 15). Perlman teaches encipher key generation and distribution where keys have limited terms (abstract; column 6, lines 13-17). However, neither Stefik et al. nor Perlman specifically disclose generating an encrypting key using a random variable unique to user device.



Chou et al. teach a method for generating an encryption key that is unique to the receiving apparatus using a random variable (abstract; column/line 2/40-3/13). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stefik et al., Perlman and Chou et al. in order to prevent a content receiving party from making content accessible to other unauthorized parties ('357, column/line 2/40-3/13).

9. Claims 33, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,233,684 and Perlman, U.S. Patent No. 6,363,480 as applied to claims 1, and in further view of Hartrick et al., U.S. Patent No. 5,532,920.

As per claims 33, 34 and 37, Stefik et al. teach a secure content distribution system where content is enciphered and access is determined by creator rights (figures 6, 7, and 15). Stefik et al. also teach an apparatus with a notifying part (column 15, lines 54-65). Perlman teaches encipher key generation and distribution where keys have limited terms (abstract; column 6; lines 13-17). However, neither Stefik et al. nor Perlman specifically disclose notifying an external apparatus if actions are not valid. Hartrick et al. teach a system of distributing content where an external apparatus is notified if an action at a user computer regarding use of said content is not valid (column/line 4/58-5/3) and updating software if deciphered data is valid (figures 2, 8A and B; column 5, lines

42-63). Therefore, it would have been to one of ordinary skill to combine the teachings of Stefik et al., Perlman and Hartrick et al. in order to allow a user to obtain new usage rights over content.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

May 18, 2005

JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100